

DOCKET NO.: 04191

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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

IN RE APPLICATION OF : **MAIL STOP AMENDMENT**

John Phillip BROWN : Art Unit: 3641

Serial No.: 10/510,948 : Examiner: Troy Chambers

Filed: October 28, 2004 :

For: CAP FOR ATTACHMENT TO A BARREL AND STORAGE MEANS THEREFOR

**RESPONSE TO ELECTION REQUIREMENT**

U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Amendment  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

This is in response to the election requirement that was made on October 19, 2006, in the above-identified application.

The Office has required the Applicant to elect one of the following species for examination:

Group A: Species A1 directed to Figs. 1-5; Species A2 directed to Fig. 6; Species A3 directed to Fig. 7; and

Group B: Species B1 directed to a cap comprising camouflage coloring; Species B2 directed to a cap that is luminescent.

Applicant hereby elects, with traverse, Group A, Species A1 directed to Figs. 1-5; Species A2 directed to Fig. 6; Species A3 directed to Fig. 7.

It is Applicant's belief that claims 1-17 are readable on Species A1 directed to Figs. 1-5; Species A2 directed to Fig. 6; Species A3 directed to Fig. 7.

This election is made with traverse for the following reasons:

The present application was filed under 35 U.S.C. § 371 as a U.S. National Phase application of PCT/CA03/00687 and, as such, is subject to the unity requirements set out in PCT Rules 13.1-13.4 and 37 C.F.R. §1.475, as well as the PCT Administrative Instructions and Annex B. It is to be further noted that the scope of the claims presently before the U.S. Patent and Trademark Office is identical to that of the claims of the International application.

In the present application, the International Preliminary Examination Authority has already reviewed unity of invention during International preliminary examination. No finding of lack of unity was made during the International stage. It is therefore apparent that the International Preliminary Examination Authority has already determined that the criteria of PCT Rule 13 are satisfied in this application.

Furthermore, according to Article 27, paragraph 1, of the PCT, it is not permissible for a national office to require compliance with requirements that are different from or in addition to the implementing rules of the PCT and the Regulations.

In view of the foregoing, it was clearly improper for the Examiner to raise an objection of lack of unity of invention during the US national phase of the present U.S. National Phase application.

Even assuming, *arguendo*, that it is proper for an objection of lack of unity to be raised in this U.S. national phase application, it is Applicant's belief that the Examiner has improperly applied the "unity of invention" criterion of PCT Rule 13.

Under PCT Rule 13, the Applicant is entitled to examination of a single inventive concept (unity of invention) as determined by a technical relationship among the groups that involves at least one common or corresponding special technical feature.

Rule 13.1 stipulates that an International application shall relate to an invention or to a group of inventions so linked as to form a single general inventive concept.

Rule 13.2 explains that a single general inventive concept exists between the inventions of the claims when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features, said "special technical features" meaning those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In the present application, the special technical feature that is common to all of the claims is the requirement for a removably attachable cap (1), which feature defines a contribution that each of the claims, considered as a whole, makes over the prior art. The color features of the cap are preferred embodiments of the invention.

Since the Examiner provides no credible evidence that this special technical feature does not make a contribution over the prior art, a holding of lack of unity of invention of the presently amended claims is inconsistent with PCT Rule 13 and 37 C.F.R §1.475.

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The Applicant therefore respectfully requests that the restriction requirement issued by the Examiner be favorably reconsidered and withdrawn.

It is believed that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,



Date: November 20, 2006

Malcolm J. MacDonald

Reg. No. 40,250